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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/712,400	11/12/2003	Wesley Gervais	130109.420D1	6850

500 7590 11/07/2005

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EXAMINER
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HU, HENRY S

ART UNIT	PAPER NUMBER
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1713

DATE MAILED: 11/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/712,400	<b>Applicant(s)</b> GERVAIS ET AL.	
	<b>Examiner</b> Henry S. Hu	<b>Art Unit</b> 1713	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on Pre-Amendment of April 23, 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 12-48 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 12-48 are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 November 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |                                                                                                                        |                                                                                         |
|------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                                                       | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____                                                |

### **DETAILED ACTION**

1. It is noted that this application 10/712,400 filed November 12, 2003 is a **DIV of 10/015,528 filed on 12/12/2001, now US Patent No. 6,679,979**. It is noted that USPTO has received **Pre-Amendment** filed on April 23, 2004. Claims 1-11 were cancelled, while parent Claim 12 was amended to incorporate the amended limitations of previously allowed parent Claim 1. **Claims 12-48** with three independent claims (**Claims 12, 23 and 36**) are now pending. An action follows.

### ***Election/Restrictions***

2. Restriction to one of the following inventions is required under 35 U.S.C. 121:
- I. **Claims 12-22**, drawn to **a catalyst ink** comprising an aqueous ionomer gel and a catalyst, classified in class 428, subclass 421.
  - II. **Claims 23-35**, drawn to a process of making an aqueous ionomer gel of Group I by **heating** the aqueous solution and then **evaporating** to remove the nonaqueous solvent, classified in class 524, subclass 547.

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III. **Claims 36-48**, drawn to a different a process of making an aqueous ionomer gel of Group I by freezing the aqueous solution and then thawing, classified in class 526, subclass 89.

3. The inventions are distinct, each from the others because of the following reasons:

**Inventions II and III** are unrelated methodologies. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different invention Group II was drawn to a process of making an aqueous ionomer gel of Group I by **heating** the aqueous solution and then **evaporating** to remove the nonaqueous solvent, while Group III was drawn to a somewhat different a process of making an aqueous ionomer gel of Group I by freezing the aqueous solution and then thawing, therefore the scope of the claims, i.e., the metes and boundaries are distinct. Although both inventions may contain the same fundamental perfluorinated monomers as well as process by the same type of polymerization, **they are actually producing two different ionomeric copolymers** due to the presence or absence of other process steps. Each process of making is unique and thereby not interchangeable.

4. **Group I** relates to an article claim as **a catalyst ink** comprising an aqueous ionomer gel and a catalyst, while each of **inventions II and III** is related to a methodology claim. **Such a specific polymer disclosed in Group I may be one option of the copolymers mentioned from**

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**Group II or Group III.** However, **Inventions I and III** as well as **Inventions I and II** are unrelated.

5. Because these inventions are distinct for the reasons given above and the search required for each group is not required for other groups have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

6. No phone call was made to Karl R. Hermanns (tel: 206 622-4900) by the examiner due to the complexity and similarity among Applicants' applications of 10/015,528 and 10/712,400. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

7. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).


### ***Conclusion***

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8. Any inquiry concerning this communication or earlier communication from the examiner should be directed to **Dr. Henry S. Hu whose telephone number is (571) 272-1103**. The examiner can be reached on Monday through Friday from 9:00 AM –5:00 PM.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu, can be reached on (571) 272-1114. The fax number for the organization where this application or proceeding is assigned is (571) 273-8300 for all regular communications.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Henry S. Hu

Patent Examiner, art unit 1713, USPTO

November 1, 2005

  
DAVID W. WU  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 1700